

REMARKS/ARGUMENTS

The Office Action mailed May 4, 2004 has been reviewed and carefully considered. Claims 1-8 are canceled. Claims 14, 17 and 18 have been amended. Claims 9-19 are pending in this application, with claim 9 being the only independent claim. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

In the Office Action mailed May 4, 2004, claims 9, 12, 13, 15 and 16 are allowed.

Claims 10, 11, 18, and 19 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to provide an adequate description of the claim limitations in the specification. In claims 10 and 11, the Examiner alleges that the limitation that the knife-supporting disk rotates at speeds greater than (for claim 11, greater than two times) the rotating speed of the input shaft is not described by the examples given in the specification. The Examiner rejects claims 18 and 19 because the Examiner states that claims 18 and 19 are directed to and supported by only Figs. 5 and 6, and that claim 9, from which these claims depend, is not considered by the Examiner to be consistent with or generic to the embodiment in Figs. 5 and 6.

The written description requirement under 35 U.S.C. §112, first paragraph, requires that the originally filed disclosure must convey to those skilled in the art that applicant had possession of the claimed invention. A specification may, within the meaning of 35 U.S.C. §112, first paragraph, contain a written description of a broadly claimed invention without describing all species that the claims encompass, *Cordin Corp. v. Medtronic AVE & Inc.*, 67 USPQ7d 1876, 1886 (CAFC 2003) (quoting *Utter v. Hiraga*, 6 USPQ2d 1709 (Fed. Cir. 1988)). In the present invention, each of the examples described in the specification clearly show that the knife-supporting disk rotates at a rotational speed that is greater than the input shaft rotational speed. In fact, this is

admitted by the Examiner who states in the middle of page 2 of the Office Action that "it would be agreed that the knife supported disk in the described embodiments is clearly rotating faster than the input shaft...". If this is so, and it is, then the specification does support claim 10 based on the Examiner's admission.

The problem which seems to trouble the Examiner is that the specification does not specifically describe the rotational speed of the knife-supporting disk relative to the input shaft rotational speed. Rather, the specification merely provides illustrative examples. For example, paragraph 0023 of the specification indicates the desirability of a high speed of the knife but does not specifically describe limits on the gear reduction ratios used to accomplish the high speed. Also, the Examiner notes that specific speed ratios of 2.33 and 2.5 are disclosed. However, claim 10 covers a speed ratio of 1.1 which is not specifically disclosed. Why not? What would have constituted a disclosure that the Examiner would have found adequate on this point? Is it necessary to have used the exact words in claim 10, namely "rotating... input shaft rotational speed"? Or, is it necessary to have specified a ratio of 1.1? The answer is NO for at least the following reasons:

1. As pointed out above, according to the Cordin Corp. decision, and many others, it is not necessary to describe all species encompassed by a claim.
2. The Examiner admits that the specification discloses the knife supporting disk rotating faster than the input shaft.
3. The specification discloses to those skilled in the art that a high speed of the knife is desirable and that this may be achieved by a gear reduction ratio between, for example, the planet gears and planet carrier.
4. The specification does not provide any specific limitations on the relative rotational speed of the knife supporting disk to exclude speed ratios below, for example, 2.33.

5. A sentence in par. [0023] states that desired results are attained by "wisely choosing the gear reduction ratio" mentioned above.

In view of the above remarks, it is respectfully submitted that the specification contains an adequate written description of the limitations of claim 10 under 35 U.S.C. §112, first paragraph.

Regarding claim 11, the limitation recited therein requires that the rotational speed of the knife supporting disk is at least two times the input shaft. This is adequately supported by the disclosed embodiments with ratios 2.33 and 2.5. Furthermore, it is explicitly described in the specification at paragraph [0008] which states that "the design of the control is such that the knife is active at the cutoff point every n passage, n being greater than or equal to two." In view of the above remarks, it is respectfully submitted that the specification includes an adequate written description of the limitations of claim 11 under 35 U.S.C. §112, first paragraph.

Regarding claim 18, the Examiner contends that the recitation of the "knife moves along a closed path which passes proximate the cutoff point but passes through the cutoff point only every n passes of the knife proximate the cutoff point, where n is greater than or equal to two", fails to read on the embodiment of Figs. 5 and 6 because there is no description that the knife in Figs. 5 and 6 crosses the cutoff point every n passes, wherein n is greater than or equal to two. It is respectfully submitted that this position is not well taken for at least the following reasons.

1. Paragraph [0008] of the summary of the invention states, without specifying any particular embodiment (it refers only to "actuating gear", and both embodiments are described in connection with gears), that the knife may be active at the cutoff every n passes, where n is greater than or equal to two.
2. The specification states that the cutting device is set up so that the knife crosses the reinforcement, i.e., the cutoff point, when the outwardly extended part of the cam 146 is

engaged by the stud 136 (see the last sentence of paragraph 0026). Since the rotary disk carrying the knife is directly connected to the gear 145 on the cam, the disk carrying the knife rotates a specific number of revolutions for each revolution of the cam 146. The disclosure of Figs. 5 and 6 and paragraph [0008] reasonably conveys to one skilled in the art the recited movement of the knife in a closed path which passes proximate the cutoff point but passes through the cutoff point only every n passes of the knife proximate the cutoff point.

3. Par. [0026], which describes Figs. 5 and 6, states that "knife 142 is continuously driven at high speed." [Par. 0023] which describes the first embodiment, also uses the term "high speeds" as being due to the gear reduction effect. The applicable description to attain "high speeds" in the first embodiment is clearly applicable to the "high speed" stated in connection with the second embodiment without the necessity of repeating what has already been stated.

Thus, claim 18 is adequately supported by the specification under 35 USC 112, first paragraph.

With regard to claim 19, the comments made above with respect to claim 11 are also applicable thereto.

In view of the above remarks, the Examiner's assertion that independent claim 9 is not generic to the embodiments in Figs. 3, 4, 5, and 6 is incorrect and the specification includes an adequate written description of claims 18 and 19. Accordingly, the rejection of claims 10, 11, 18 and 19 under U.S.C. §112, first paragraph should now be withdrawn.

Claims 14 and 17-19 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner states that lines 2-3 of claim 14 reciting "application roller

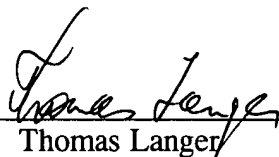
bearing" is indefinite. Claim 14 has been amended to recite an --application roller bearing on the support--. In view of the amendment, the rejection of claim 14 should now be withdrawn. The Examiner states that claims 17 and 18 are indefinite because it is not clear if the "n" revolutions of the planet carrier recited in claims 17 corresponds to the "n" passes of the knife recited in claim 9. Claims 17 and 18 are amended to clarify that the variable "n" recited in these claims is the same variable "n" recited in claim 9. In view of the amendments, the rejections of claims 14 and 17-19 as indefinite should now be withdrawn.

The application is now deemed to be in condition for allowance and notice to that effect is solicited.

It is believed that no fees or charges are required at this time in connection with the present application other than the time extension fee for which a check is enclosed. However, if any additional fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

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Dated: September 29, 2004